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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,247	04/02/2007	Reed Gamble	330499.00050	3023
27160	7590	11/10/2008	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP (C/O PATENT ADMINISTRATOR) 2900 K STREET NW, SUITE 200 WASHINGTON, DC 20007-5118			GEORGE, KONATA M	
ART UNIT	PAPER NUMBER		1616	
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11/10/2008	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/573,247	GAMBLE, REED
	Examiner KONATA M. GEORGE	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 June 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 and 25-31 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-23 and 25-31 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 23 March 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-13 and 25-31 are pending in this application.

#### ***Action Summary***

Any rejections of record that are not repeated below are considered withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-15, 18-20, 22-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins (US 5,352,457) in view of Edwards et al. (US 6,037,280), Woods (WO 02/059407) and von Trebra et al. (US 5,609,945).**

Applicant claims a patch comprising a first layer that is adhesive and a second layer comprising a material adjacent to the first layer, wherein at least one of the first and second layers is opaque to UV radiation.

#### ***Determination of the scope and content of the prior art (MPEP §2141.01)***

Jenkins teaches in Figure 1, a transdermal device comprising a backing adjacent to an adhesive layer. Column 5, lines 32-36 teach examples of materials that can be used as the backing layer such as metallized polyester laminate.

***Ascertainment of the difference between the prior art and the claims***  
**(MPEP §2141.02)**

Jenkins does not teach the addition of a UV radiation blocking agent or calendering the blocking agent or the shape of the patch being circular. It is for this that Edwards et al. and Woods are joined. Jenkins does not teach that the patch is substantially transparent to visible light. It is for this that von Trebra et al. is joined.

Edwards teaches the use of UV blocking particles on fabrics for the purpose of deflecting, reflecting, absorbing and/or scattering ultraviolet rays (col. 2, lines 10-15). Column 2, lines 34-51 disclose examples of the UV blocking particles, including metal oxides and its salts.

Woods teaches a method for calendering fabrics for improving the performance of UV blocking agents.

von Trebra et al. teach in examples 1-3, that metallized polyester films prior to coating have a 20% visible light transmission.

***Finding of prima facie obviousness***  
***Rational and Motivation (MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Edwards and Woods in the invention of Jenkins to arrive at the claimed invention. As mentioned above, Jenkins teaches the patch as claimed with the addition of the UV blocking agent or calendering the patch. The addition of an UV blocking agent would have been obvious to one of ordinary skill in the art as an additional means of blocking the harmful effects of UV radiation. It

would have been within the skill of one in the art after the addition of additional UV protection, to improve the performance. To do so one could look to the teachings of Woods. With respect to the shape of the patch, one of ordinary skill in the art could design the patch in any manner that would suit the purpose of the patch, which could include the shape of the patch. As mentioned above, Jenkins fail to teach that the patch is substantially transparent to visible light. von Trebra et al. is relied upon to teach that visible light is transmitted through metallized polyester films. It is therefore the position of the examiner that the combinations of references teach the claimed invention and is thus obvious.

#### ***Response to Arguments***

Applicant's arguments filed June 25, 2008 have been fully considered but they are not persuasive.

Applicants have amended the claims to recite that the patch is substantially transparent to visible light. The examiner disagrees. In the office dated March 27, 2008, the examiner acknowledges that it was stated that the metallized polyester films of Jenkins can reflect visible light as well as UV radiation. Upon research the newly amended claims it was discovered that metallized polyester films in fact transmit visible light at about 20% (see examples 1-3 of von Trebra et al.). Because applicant has not defined by way of numerical value how much "substantially" is, the examiner is relying on the information of von Trebra et al. as to the ability of metallized polyester films ability to transmit light.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-23 and 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Applicant uses the word "substantially" when describing the transparency of visible light, the shape of the patch and the waterproof characteristics of the patch. However, it is not defined in the specification as to what "substantially" is, by way of numerical value. For example, when describing the transparency of visible light of the patch, is the patch 99% transparent to visible light or is it 51% transparent to visible light. The same argument applies to the shape of the patch and the waterproof characteristics of the patch.

***Conclusion***

Claims 1-23 and 25-31 remain rejected.

***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Konata M. George/  
Patent Examiner, Art Unit 1616